



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/406,486	09/27/1999	YOICHIRO SAKO	450100-02102	1659

20999 7590 02/24/2003
FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

[REDACTED] EXAMINER

BACKER, FIRMIN

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

3621

DATE MAILED: 02/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicant No.	Applicant(s)	
	09/406,486	SAKO ET AL.	
	Examiner	Art Unit	
	Firmin Backer	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 31 December 2002.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 31st, 2002 has been entered.

Preliminary Amendment

2. A preliminary amendment has been filed on December 31st, 2002 in which claims 1, 14-16, 18, 20 and 22 have been amended. Claims 1-22 are pending in the letter.

Claim Objections

3. Claim 16 is objected to because of the following informalities: Applicants inappropriately disclose “information distributing means”, “a transaction means” and “means for controlling” in a method claim. Appropriate correction is required.

4. Claim 22 is objected to because of the following informalities: Applicants disclosed “changing said amount of money to be billed” this disclosure is unclear. Applicants are advised to replace “changing said amount of money” with “charging said amount of money” in order to overcome examiner’s objection.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

6. Claims 1, 14-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed to be statutory, the claimed invention must be within the technological arts.

Mere ideas in the abstract (i.e., abstract idea law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” and therefore are found to be non-statutory subject matter. For a method claim to pass the muster, the recited method must somehow apply, involve, use, or advance the technological arts.

In the present case the inventive concept in claim 1, 14-16 only recite an abstract idea. The recited concept of information distributing information method does not apply, involve, use or advance the technological arts since all the steps can be performed in the mind of the user or by use of pencil and paper and no specific technology (e.g. computer, processor) is expressly recited in the body of the claims. *In re Toma (CCPA 197 USPQ 852 (1978))*.

Although the recited method produces a useful, concrete and tangible result, since the claimed invention, as a whole, it not within the technological arts as explained above, claim 1 deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenthal (U.S. Patent No. 6,148,301) in view of Christenson et al (U.S. Patent No. 6,324,620).

9. As per claims 1, Rosenthal teaches an information distributing method (*information distributed system 10*) for distributing information subjected to billing (*see abstract, fig 2, column 3 lines 36-52*), characterized in that an amount of money billed every time the information is distributed (*see abstract, figs 1-3, column 5 lines 56-6 line 16*). Rosenthal fails to teach an inventive concept where distributed information is determined depending on the number of times that the information is distributed within a predetermined time period. However Christenson et al teach inventive concept where distributed information is determined depending on the number of times that the information is distributed within a predetermined time period (*see abstract, column 2 lines 51-54, 3 lines 56-67*). Therefore, it would have been obvious to one

of ordinary skill in the art at time the invention was made to modify Rosenthal's inventive concept to include Christenson et al's inventive concept where distributed information is determined depending on the number of times that the information is distributed within a predetermined time period because this would have allow an information distribution technique which allows recipients the capability to easily change or modify document requests/received such that new/common subject matters that produced the greatest amount of revenue are easily added, and that the distribution non accessed subject matters are easily discontinued.

10. As per claims 2-8, Rosenthal teaches an information distributing method wherein the time period is one from a predetermined time point to a current time point, a definite term from a predetermined time point, one from an optionally set time point to a current time point or a second optionally set time point, a definite term down to the current time point and until an optionally set time point (*see column 6 lines 59-7 line 10*).

11. As per claims 9, 10, Rosenthal teaches an information distributing method wherein when the number of times of distribution reaches a previously set number of times or more, the amount of money billed for the information is raised or reduced (*see column 6 lines 59-7 line 10*).

12. As per claims 11, Rosenthal teaches an information distributing method wherein the amount of money billed for the information is determined depending on a value obtained by substituting the number of times of distribution for a previously set function (*see column 8 lines 16-47*).

13. As per claims 12, 13, Rosenthal teaches an information distributing method wherein the information is audio information, video information, game information or book information, or any combination of them distributed by using wireless communication or wired communication (*see column 4 lines 25-45*).

14. As per claims 14, 15, Rosenthal teaches an information distributing system (*information distributed system 10* for distributing information subjected to billing (*see abstract, fig 2, column 3 lines 36-52*), characterized in that an amount of money billed every time the information is distributed (*see abstract, figs 1-3, column 5 lines 56-6 line 16, see also column 1 lines 61-2 line 9*). Rosenthal fails to teach an inventive concept where distributed information is determined in a composite manner depending on the respective numbers of times that the information is distributed in a plurality of set terms. However Christenson et al teach inventive concept where distributed information is determined in a composite manner depending on the respective numbers of times that the information is distributed in a plurality of set terms (*see abstract, column 2 lines 51-54, 3 lines 56-67*). Therefore, it would have been obvious to one of ordinary skill in the art at time the invention was made to modify Rosenthal's inventive concept to include Christenson et al's inventive concept where distributed information is determined in a composite manner depending on the respective numbers of times that the information is distributed in a plurality of set terms because this would have allow an information distribution technique which allows recipients the capability to easily change or modify document requests/received such that

new/common subject matters that produced the greatest amount of revenue are easily added, and that the distribution non accessed subject matters are easily discontinued.

15. As per claims 16, 18 and 20 Rosenthal teaches an information distributing system (*information distributed system 10*) for distributing information subjected to billing (*see abstract, figs 1-3, column 5 lines 56-6 line 16*), comprising an information distributing means for distributing the information to a user (*subscriber/recipient, 14*) means for controlling a billing system depending on the number of distribution counted (*see abstract, fig 2, column 3 lines 36-52 also see column 9 line 5-17*). Rosenthal fail to teach a transaction means comprised of a means for counting a number of distribution of the information to a user. However, Chistenson et al teach a transaction means comprised of a means for counting a number of distribution of the information to a user (*see 10 lines 2-13*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rosenthal et al' inventive concept to include Christenson's transaction means comprised of a means for counting a number of distribution of the information to a user because this would have to prevent trashing and also provided and system wherein a utilization threshold is determined with respect to the average frequency of access in order to determine whether an information is overutilized, underutilized, or average. Such a threshold amount may be defined by the user with respect to a particular information distributed and could be adjusted accordingly to increase or decrease the distribution process.

16. As per claims 17, 19, 21, Rosenthal teaches an information distributing system wherein the transaction means comprises a means for comparing the counted distribution number with a reference value (*see column 9 line 5-17*).

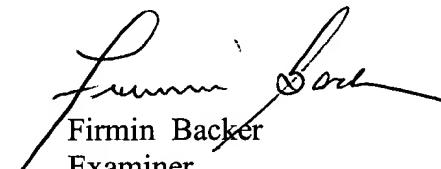
17. As per claim 22, Rosenthal teaches a transaction method to control a billing system for an information distributing system (*information distributed system 10*) comprising charging the amount of money to be billed to each user for the next subsequent distribution of the content on the result of the previous distributions and bill each user the amount of money (*see abstract, fig 2, column 3 lines 36-52 also see column 9 line 5-17*). Rosenthal fail to teach a counting the number of times that content is previously distributed to each user during a predetermined time period. However, Chistenson et al teach a transaction method for counting the number of times that content is previously distributed to each user during a predetermined time period (*see 10 lines 2-13*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rosenthal et al' inventive concept to include Christenson's transaction method for counting the number of times that content is previously distributed to each user during a predetermined time period because this would have to prevent trashing and also provided and system wherein a utilization threshold is determined with respect to the average frequency of access in order to determine whether an information is overutilized, underutilized, or average. Such a threshold amount may be defined by the user with respect to a particular information distributed and could be adjusted accordingly to increase or decrease the distribution process.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Firmin Backer
Examiner
Art Unit 3621

February 23, 2003